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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,622	11/29/2001	Silvio Pupin	GB920000110US1	7090

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IBM Corp, IP Law, N50/040-4  
1701 North Street  
Endicott, NY 13760

EXAMINER

PHAN, THIEM D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/997,622

Applicant(s)

PUPIN ET AL.

Examiner

Tim Phan

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicants' election with traverse of Group I (Claims 1-10) in Paper No. 4 is acknowledged. The traversal is on the ground(s) that the examiner has not established a prima facie case of serious burden of examination of the inventions of Groups I and II together. This is not found persuasive because the examiner has established a prima facie case having shown in Paper No. 3, that the invention of Group I has a separate classification (Class 29, subclass 426.2) from the invention of Group II (Class 29, subclass 842). Moreover, the inventions of Groups I and II each have a separate status in the art and clearly have a separate field of search.

In accordance with MPEP § 803, the examiner has demonstrated that the inventions of Groups I and II are each independent or distinct as claimed (indicated in Paper No. 3) and a serious burden would be placed on the examiner as discussed above. The requirement is still deemed proper and is therefore **made FINAL**.

Claims 11 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, there being no allowable generic or linking claim.

Applicants are required to cancel these nonelected Claims (11 and 12) or take other appropriate action.

An Office Action on the merits of Claims 1-10 now follows.

*Title*

2. The following title is suggested: "A Method Of Manufacturing A Folding Top For A Convertible".

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These apparatus claims are written in such a manner so that they produce merely a catalogue of unrelated parts. In other words, the recited apparatus is non-functional.

Also the term "adapted for" (Claim 1, line 5) performs a function that is not a positive limitation but only require the ability to so perform. It does not constitute a limitation in any patentable sense. *In re* Hutchinson 69USPQ 138.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (US 6,138,345) hereinafter '345.

**As applied to claim 1**, the '345 teaches an apparatus for inserting and extracting metallic pins of press-fit connector of matrix switch board which reads on applicants' claimed limitations, including:

- first and second jaws (Cf. Fig. 24, element 55) for removing insertion pins;
- a holding structure (CF. Fig. 26, elements 80-86) for moving jaws (Cf. fig. 25, element 55) away from the switch board (Cf. Fig. 24, element 90) without damage to adjacent metallic pins.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the shell housing of the press-fit connector to the metallic pin body in order to grasp the connector housing with the two parallel jaws for removal.

**As applied to claim 2**, the '345 teaches the grasping by the two jaws of the device (CF. Fig. 25, element 40) and its parallel removal.

**As applied to claim 3**, the '345 teaches that the jaw is wedge-shaped (Cf. Fig. 24, element 551) with an inclined surface of the device to be pulled out.

7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '345 in view of Ota et al (US 5,509,192) hereinafter '192.

**As applied to claim 7**, the '345 teaches the claimed invention, including a drive structure to pull the two jaws along a direction parallel to the longitudinal axis of the device (CF. Fig. 26, element 81).

The '192 teaches as old art (Cf. Fig. 11, element 3a) the horizontal gripping movement of the two jaws for expansion or shrinkage.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the reference of the horizontal expansion of the gripping mechanism, as taught by the '192, in order to have a large number of sizes for the two jaws to grip.

**As applied to claim 8**, the '192 teaches a conveyor mechanism where the drive structure for the gripping jaws is mounted (CF. Fig. 11, element 3b).

**As applied to claim 9**, the '345 and '192 teach the claimed invention, except for locking the structure in a selected position.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to lock the structure in a selected position since it was known in the art that the mechanism has a position detector, a controller (Cf. Abstract) and stock of connectors to be removed by the conveyor unit (Cf. column 1, lines 27-30).

**As applied to claim 10**, the '345 and '192 teach the claimed invention, except for having a pressing member to prevent removal of adjacent module.

It would have been an obvious matter of design choice to have a pressing member to prevent removal of adjacent module by mistake since it was known in the art that there is a position detector and a controller that will pinpoint the shell housing of the connector to be removed.

***Allowable Subject Matter***

8. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 703-605-0707. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Tim Phan  
Examiner  
Art Unit 3729

tp  
December 8, 2003



CARL J. ARBES  
PRIMARY EXAMINER